

DOCKET NO.: 270410US0PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

GROUP: 1625

Peter BASSLER, et al.

SERIAL NO: 10/531,868

EXAMINER: Oh, Taylor V.,

FILED: April 19, 2005

FOR: CONTINUOUS RECIRCULATION OF THE OLEFIN WHICH HAS NOT
BEEN REACTED IN THE OXIDATION OF OLEFINS BY
HYDROPEROXIDES, BY MEANS OF SOLVENT SCRUBBING

RESTRICTION RESPONSE

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

Sir:

In response to the Restriction Requirement dated August 1, 2007, Applicants elect, with traverse, Group I, Claims 1-18, for examination.

REMARKS/ARGUMENTS

The claims have been divided into Groups as follows:

- Group I: Claims 1-18, drawn to a process for the continuous recirculation of the propene which has not been reacted in the oxidation of propene by means of hydroperoxide to give propene oxide.
- Group II: Claim 19, drawn to an apparatus for carrying a process for the continuous recirculation of the propene, comprising at least one reactor, at least one absorption and the desorption unit.

Applicants elect, with traverse, Group I, Claims 1-18, for examination.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of lack of unity of invention.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples

to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding technical features. The examiner has cited Bolme. (U.S. 4,118,460) and states:

“From this prior art, it shows that the same kind of the apparatus as Group II in the claimed invention can be used to produce the materially different product, such as nitrogen oxides from industrial gases by the oxidation process. Thus Group II is not the special technical feature required in the process for the continuous recirculation of the propene which has not been reacted in the oxidation of propene by means of hydroperoxide to give propene oxide.”

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims interpreted in light of the description was adequately considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion. Applicants respectfully point out that the apparatus described in Claim 19 includes a C-3 splitter which separates the propene from propane. The example cited by the Office does not show such a splitter and therefore Applicants respectfully submit that the apparatus described in Claim 19 is specifically designed for the claimed process.

Moreover 37 C.F.R. § 1.475(b) states in pertinent part:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(4) A process and an apparatus or means specifically designed for carrying out the said process, . . .”

Applicants respectfully submit that the Examiner has not considered the relationship of the inventions of Groups I, and II with respect to 37 C.F.R. § 1.475(b)(4) and therefore has not met the burden necessary according to MPEP § 1893.03(d) to sustain the conclusion that the groups lack of unity of invention.

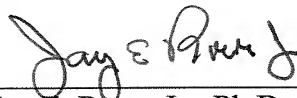
Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of lack of unity of invention.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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